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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,953	03/28/2001	Paul Alan Stirpe	03433.00003	9620
22907	7590	02/03/2005	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			SMITH, TRACI L	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/818,953

Applicant(s)

STIRPE ET AL.

Examiner

Traci L Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to papers filed on November 15, 2004.
2. Claims 1-61 are rejected.
3. Claims 1-61 are pending.

#### Response to Remarks/Arguments

4. Examiner respectfully withdraws rejections of claims 44-46 under 35 USC 112 1<sup>st</sup> paragraph, as changes made to specification allowed the incorporated reference to be found with the correction of the application number.
5. Rejections of claims 9-10 under 35 USC 112 2<sup>nd</sup> paragraph are withdrawn as amended claims overcome rejection.
6. Rejection of claim 18 under 35 USC 112 2<sup>nd</sup> paragraph as indefinite are withdrawn as the examiner makes a new rejection below under 35 USC 112 1<sup>st</sup> paragraph.
7. Applicant's arguments filed 11/15/2004 have been fully considered but they are not persuasive. The applicant makes the argument for claims 1, 19, 31, 40-41, 47, 52 and 57 rejected under 35 USC 102(e) that Papierniak does not teach the used of nodes that represents relationships. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., nodes) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). During patent examination, the pending claims must be "given their" broadest

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reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The examiner interprets nodes as identifiers for the ontologies and/or categories creating an organizational factor for the information. Examiner points to C. 13 I. 17-23;

Papierniak teaches "the processed data must be organized in a structured way."

8. The applicant further argues that Papierniak fails to teach "tagging" data.

Again the examiner interprets tagging as a description of the data and or characteristics of the data. The examiner points to Pg. 25 ¶ 9 the applicant refers to tags as attributes which according to the Merriam Webster Dictionary 10<sup>th</sup> addition is an inherent characteristic and/or close association. The examiner directs the applicant to C. 18 I. 45-48 where Papierniak teaches classifying according the characterizations.

9. The examiner makes note that in arguments applicant did not argue the combination of references as reasons for improper rejections to claims 20, 24, 51 and 54 under 35 USC 103(a), rather argued that limitations a were not taught by Papierniak the rejection stands and arguments are non-persuasive.

#### New Rejections

#### ***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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11. Claims 1-18 and 44, 47-51, 60-61 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the idea of an inferencing engine and an analytics counsel, does not reasonably provide enablement for how the inferencing engine used the data to derive and/reason a consequence or how the analytics counsel "analyzes" the data. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use an inferencing engine that generates the consequences or make and use the analytics counsel to determine relationships to enable the invention commensurate in scope with these claims. As the specification states utilizing the reasoning or "algorithms", who or what and how are the consequences generated with "reason"?, how is the information derived? What algorithms are used to generate consequences? What data is used in the generation of the consequences and how is it used? As for the analytic counsel the in response to the original 112 2<sup>nd</sup> rejection the applicant pointed to Fig. 10, Ref . 1322 to describe the analytics counsel. However, the figure merely shows a monitor which still does not tell the examiner what exactly is an analytics counsel. Furthermore, the applicant also pointed to paragraphs 55-57 to give more description. However, paragraph 57 is the only section where the counsel is discussed, it states that using "what if" statements to determine new relationships. How does a what if statement determine a new relationship? What are the basis of determining relationships? What data is used and how does the analytics counsel use the data to make this determination?

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12. Claims 19-46 and 52-59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant claims "drawing conclusions" and weighted nodes. The claimed invention must be enabled so that any person skilled in the art can make and use the invention without undue experimentation. In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also United States v. Teletronics, Inc., 857 F.2d 778,. The disclosure does not enable one skilled in the art to know how the conclusions are drawn, what is used to draw the conclusions and what and/when is the basis for drawing conclusions. One is also not able draw conclusions because there is not a description as to what a conclusion actually is. The applicant further claims weighted nodes. The disclosure does not enable one skilled in the art to understand the weighting system to an extent that they are able to re-create it. How does one data set get a designated weight and an different data set gets a completely different weight designation. What is the basis for weighting the nodes and when, how and by who or what is the data weighted?

***Claim Rejections - 35 USC § 102***

13. Claims 60-61 are rejected under 35 U.S.C. 102(e) as being as being anticipated by US 6,151,584 Papierniak et al.

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1. As to claims 60-61 Papierniak teaches ***a display for displaying information to a computer user***. (C. 10 I. 45-46, Fig. 4 Ref. 12). Although Papierniak does not explicitly teach they information displayed as articles and advertisement these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed regardless of the type of information presented. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).

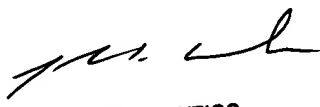
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is (703)605-1155. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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